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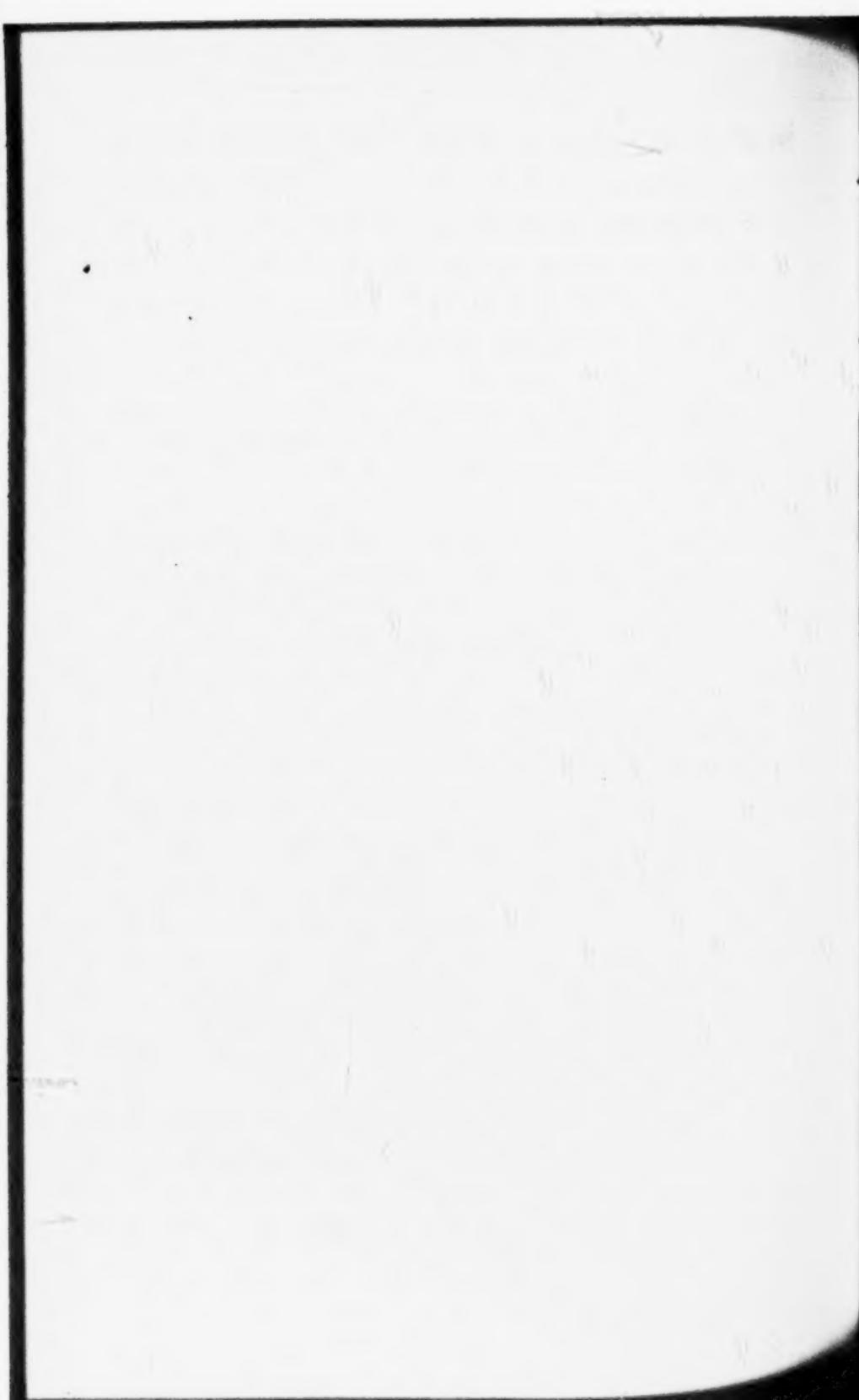
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In the Supreme Court of the United States

OCTOBER TERM, 1946.

No.

THE GENERAL METALS POWDER COMPANY,
Petitioner,

vs.

THE S. K. WELLMAN COMPANY AND S. K. WELLMAN,
Respondents.

PETITION FOR A WRIT OF CERTIORARI To the United States Circuit Court of Appeals For the Sixth Circuit.

*To The Honorable The Chief Justice and The Associate
Justices of the Supreme Court of the United States:*

Your petitioner, The General Metals Powder Company, respectfully prays that a writ of certiorari issue to review a decree of the United States Circuit Court of Appeals for the Sixth Circuit entered September 23, 1946 in the above entitled cause.

The transcript of the record, including the proceedings in the Circuit Court of Appeals, has been filed herein pursuant to Rule 38 of the rules of this Court.

(A) SUMMARY STATEMENT OF THE MATTER INVOLVED.

The petitioner is a corporation of the State of Ohio; the respondent The S. K. Wellman Company is a corporation of the State of Ohio and respondent S. K. Wellman is a citizen of the United States and a resident of the State of Ohio. In 1942 the petitioner instituted a suit against the respondents for infringement of letters patent; and on July 15, 1942 the respondents filed their answer. The Dis-

trict Court after trial found that there would be infringement if the patents could be held invalid. The judgment of the District Court dismissed the complaint on the ground that as to the claims in suit the patents were invalid for lack of invention. The Circuit Court of Appeals for the Sixth Circuit affirmed the District Court.

Review is sought of the decision on the questions of validity and invention for both of the patents in suit Nos. 2,072,070 and 2,191,460.

The District Court said in its opinion R. Vol. II p. 784.

"The evidence leaves no doubt that there had been a very great problem, that repeated efforts had come short of solution, and that plaintiff's friction article supplied a long-felt need."

The Court said also (on the same page).

"Those clutch liners gave amazing results."

And on page 787 the District Court said further:

"Instinctively he (The Court) prefers the exercise of objective to subjective judgment. Naturally the Court is prompted by a desire to see every man rewarded for whatever contribution he has made to art or industry."

The District Court entered findings and conclusions holding the claims in suit invalid and holding the claims infringed if valid. The Circuit Court of Appeals affirmed the District Court.

(B) REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

These reasons are as follows:

- (1) There is conflict of decisions between the decision of the Sixth Circuit Court of Appeals in the instant Case and the rule in the First Circuit as stated by that Court in *Grant Paper Box Co. v. Russell Box Company*, 154 Fed. (2) 729 and *Brown and Sharpe v. Kar Engineering*, 154 Fed.

(2) 48. This conflict shows the uncertainty and confusion of the lower courts in their interpretation of what constitutes "substantial innovation" as used by this Court in defining invention in the case of *Sinclair & Carroll v. Interchemical Corporation*, 325 U. S. 327, 330.

(2) There is confusion and conflict among the various Courts in the country on the question of what constitutes a standard of invention, and particularly as to whether that standard has been changed by this Court and, if so, how it has been changed.

(3) The statutory requirement of what constitutes invention is important in the patent law and the interpretation thereof is in a hopeless state of confusion among the various Circuits.

(4) The statutory requirement of invention is important, if not controlling in the patent law and this Court has granted certiorari for that reason even where there are concurring decisions below (*Halliburton v. Walker*, 71 U. S. P. Q. 175, — U. S. — November 11, 1946).

(5) The evidence of "amazing results" as stated in the Opinion of the District Court constitutes a substantial innovation—there is no evidence in this case to otherwise account for such results.

(6) There is diversity of decision between the Courts of Appeals on the question of invention and mechanical skill—mechanical skill does not produce "amazing results" in the solution of a very great problem.

(7) The public interest is not on the side of the infringer in this case. It is to the public interest, in the light of their accomplishment, that the patents here in suit be given the traditional liberal construction as set forth by this Court in *Topliff v. Topliff*, 145 U. S. 156, at page 171, as follows:

"The object of the patent law is to secure to inventors a monopoly of what they have actually in-

vented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute or by the application of artificial rules of interpretation."

See also *Eibel v. Minnesota*, 261 U. S. 45; *Smith v. Snow*, 294 U. S. 115.

Wherefore, your petitioner prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Sixth Circuit, commanding said court to certify and send to this Court on a day to be designated, a full and complete transcript of the record of all the proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals as to the Fisher patent No. 2,072,070, holding claims 2, 3, 5, 12, 13, 14 and 19 invalid and as to the Fisher patent No. 2,191,460 holding claims 1, 3, 5 and 6 invalid be reversed; and that the petitioner be granted such other and further relief as may seem proper.

THE GENERAL METALS POWDER COMPANY,

Petitioners

The image shows two handwritten signatures. The top signature is "J. Richey" and the bottom one is "B. D. Watts". Both signatures are written in cursive ink and are positioned above a dotted line.

Attorneys for Petitioner.

RICHEY & WATTS,

Of Counsel.

**BRIEF IN SUPPORT OF THE PETITION
FOR CERTIORARI.**

STATEMENT OF THE CASE.

I.

The Opinions of the Courts Below: The opinion of the Sixth Circuit Court of Appeals is reported in *The General Metals Powder Company vs. The S. K. Wellman Company*, 71 U. S. P. Q. 23 (advance sheets) (¹⁵⁷ Fed. (2)⁵⁰⁵) and is found at Record Vol. VI, pp. 2-17.

The opinion of the District Court is reported in *The General Metals Powder Company vs. The S. K. Wellman Co.*, 57 Fed. Supp. 220, 62 U. S. P. Q. 490, and is printed in the record here in Vol. II, pp. 783-788. The Findings of Facts and Conclusions of Law of the District Court are printed in the record here in Vol. II, pp. 788-791. Two patents were in suit below.

II.

(1) The jurisdiction of this Honorable Court is invoked under section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925; 28 U. S. Code Section 347.

(2) The date of the Decree below is September 23, 1946 (Vol. VI R. p. 1).

(3) This suit is a civil action arising under the patent laws of the United States and the decree of the Circuit Court of Appeals for the Sixth Circuit requires that the complaint in the suit be dismissed on the patent cause.

III.

The Issues: (1) What constitutes the "substantial innovation" upon which an invention is to be predicated in the following statement from this Court's decision in *Sinclair & Carroll v. Interchemical Corporation*, 325 U. S. 327, 330:

"A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity . . . than the work of a mechanic skilled in the art.' " (Authorities cited.)

• • • • •

"The test is often difficult to apply; but its purpose is clear. Under this test, some **substantial innovation** is necessary, an innovation for which society is truly indebted to the efforts of the patentee." (Emphasis ours throughout.)

• • • • •

(325 U. S. 331):

"Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society."

(2) The First Circuit Court of Appeals interprets the Sinclair decision as restoring the old or traditional test of invention; the Sixth Circuit Court of Appeals in its decisions in the instant cause and other causes has interpreted the same Sinclair decision as requiring more than the old or traditional test of invention.

IV.

This is a prayer rather than a petition. It is a prayer that this Court furnish industry, the inventing profession, the patent law profession, the Patent Office and the patent law Courts with a definition of invention which will at least restore all of these institutions to the status which existed prior to the recent attempts to define invention which have resulted in confusion on confusion until nobody in any of these institutions knows whether "he is afoot or on horseback," to use a colloquial but emphatic expression.

History in Connection with the Definition of Invention:

After something like one hundred or one hundred and twenty-five years of effort and thought by the best minds on the patent bench and at the patent bar, it had come to

be pretty generally accepted that the best method of distinguishing invention from mechanical skill was by relying upon the objective tests.¹ (This is what the First

¹ In *Expanded Metal v. Bradford*, 214 U. S. 366, 381 the Supreme Court in dealing with prior symptoms of invention said:

"It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

In *Temco v. Apco*, 275 U. S. 319, 324 the same Court in dealing with after symptoms said:

"The district judge in Ohio in the K-W Ignition Co. case was affected in his decision, that the Thompson patent involved invention, by the way in which the public eagerly took it and its marked success, and so, indeed, was the Circuit Court of Appeals of the Sixth Circuit. So are we."

To the same effect is the statement by Judge Alschuler speaking for the Seventh Circuit Court of Appeals in *Wahl v. Andis*, 66 Fed. (2) 162, 165, as follows:

"In most instances, the judgment of those who pay their money to secure the benefits of the patented article is truer and better than the opinion of experts or the speculations of an arbitrator. Inasmuch as experience is more reassuring than theorizing, and history more certain than prophecy, so the test of public approval, if uninfluenced by detracting factors, must afford the weightiest proof obtainable determinative of invention. In short, in construing the patent statute, which was enacted to promote the useful arts, it is more important to study those developments of the art which are bright with use in the channels of trade than to delve into abandoned scrap heaps and dust-covered books which tell of hopes unrealized and flashes of genius quite forgotten. The somewhat meaningless terms 'inventive genius' and 'mechanical skill'

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Circuit Court of Appeals characterizes as the old or traditional test in the decisions which it has rendered since the rendition of the Sinclair decision by this Court.)

So satisfactory was this practice that its incorporation in the law was recommended by President Roosevelt's Patent Planning Commission headed by Mr. Kettering, though there was never any need to do so since formerly the Courts had so interpreted the law.² Nevertheless, between one and two decades ago certain Courts took the position that the standard of invention should be raised above this plan and some of them began to raise it without, however, doing more than cutting loose from this old accepted plan or traditional test and without establishing any new plan or definition (*Armstrong v. United Work*,

(Continued from preceding page)

must be clarified by an examination of the article itself, and if the improvement be unusual, or if there be doubt, and the public has given its tribute, the judge should accord to the creator of the article the title of inventor."

In *Hookless v. Prentice*, 68 Fed. (2) 940, the Second Circuit Court of Appeals said (p. 941):

"In all such cases where the mere idea of combining old elements is the whole of the invention, we have often said that we look rather to the history of the art than to our own divinations of what was easy and apparent."

These are typical.

² On the subject of the objective test the Commission said at page 10 of its Report:

"The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

107 Fed. (2) 37 (CCA 3)).³ Other Courts actually defied the proposition that the standard was to be changed and adhered to the former standard, insisting that it was sound and should be adhered to (*Chicago Steel v. Burnside*, 132 Fed. (2) 812, 816-818 (CCA 7)).⁴

³ "The Supreme Court's standard of invention (that shifting fact question) can well be thought of as the target and the efforts of the lower courts to hit it proportionately subject to the law of probable error. The high court has in recent years moved that target-standard back.

* * * * *

"We, therefore, express to them" (the inventors) "our regret for 'the sins of the past.' "

⁴ "While this digression may not clarify the test by which invention should be measured, it may serve to reaffirm the recognized standards which throughout the past century have been applied by courts, with some degree of safety and satisfaction. They are under severe attack today, and this discussion is to emphasize the soundness of the standards which have been applied when considering the validity of patents.

* * * * *

"The test of 'flash of genius' has been applied to curtain the field of patentable discovery and to eliminate from the protection of patents, all products (even though they came from the superior mind of genius) which were, nevertheless, the product of prolonged study and step by step advance. In short, it would eliminate nearly all the advances of history, in science, and in the field of mechanics.

"The test of a 'flash of genius' should be rejected not only because it is incapable of acceptable definition but because it injects into the statute something not appearing therein. The Federal decisions covering a century contain many to the effect that *it is the fact of accomplishment*,—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned."

Other Courts admitted that some Courts had drifted from this formerly accepted sound standard and refused to follow (*In re Shortell*, 142 Fed. (2) 292 (C. C. P. A.)).⁵

Other Courts admitted the change and yielded with great reluctance, all the while looking back and pronouncing the soundness of the former standard (*Picard v. United Aircraft*, 128 Fed. (2) 632, 636 (C. C. A. 2); *Safety Car v. General Electric*, 155 Fed. (2) 937, 939 (C. C. A. 2)).⁶

⁵ "While recognizing, of course, that it is the duty of this Court to follow the law as declared by the Supreme Court, we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention.

"In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. It seems clear to us that the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation.

"It follows, from the foregoing, that until Congress shall otherwise legislate, or the Supreme Court shall otherwise specifically hold, this Court will continue to hold that if a process or thing constitutes patentable subject matter, is new and useful, and the process performed or thing produced would not be obvious to one skilled in the art, invention should be presumed and a patent may properly issue therefor."

⁶ "Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these will figure the length of time the art, though needing the invention, went without it; the number of those who sought to meet the need, and the period over which their efforts were spread; how many, if any, came upon it at about the same time, whether before or after; and—perhaps most important of all—the

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It is not difficult to appreciate the great confusion which resulted from this state of affairs and which still obtains. It is not difficult to appreciate the great waste of money and effort in proceedings aimed at testing out the attitudes of particular Courts and of seeking some uniformity of decision and some standard or definition of invention which would serve as a guide to the various institutions which we have named, including the inventors. There has also necessarily been confusion in the Patent Office as a result of this confusion in the Courts, and a great deal of the criticism of the Patent Office and its practices results from these confusions in the Courts and from the failure of the Courts to agree upon some standard of invention or to return to the standard of invention which existed prior to the departure therefrom.

Into this situation came the much discussed and much criticized effort to define invention by what is known as the "flash of genius" test. The difficulty was that nobody could tell what constituted the required "flash," and even then "genius" was just as much unstandardized and indeterminate as "invention," so that instead of being without a single standard, i.e., the standard of "invention," the institutions which we have named were without a standard or a definition of the "flash" required and of the "genius."

After that this Court on May 21st, 1945 handed down its decision in *Sinclair v. Interchemical, supra*, with the statement which we have quoted *supra*, (pp. 5-6) stating that under the test of invention "some substantial innovation is necessary for which society is truly indebted to the

(Continued from preceding page)

extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions."

efforts of the patentee." We now invite this Court to clear up the confusion which now exists relating to the following subjects:

Does the "substantial innovation" relate to a substantial innovation:

In structure?

In mode of operation?

In results?

In contribution to the public welfare?

Or in advances in knowledge beneficial to society?

And thereafter what constitutes a "substantial innovation" in each or any of these to which the term "substantial innovation" relates?

It is well recognized that in a mechanical invention there is involved (1) structure, (2) mode of operation and (3) results, and in the method invention there is involved (a) mode of operation and (b) results, and in both there is involved a contribution to human welfare or to what is known as the "art."

Of course, a return to the objective test standard or the "old or traditional test" of invention in vogue prior to the influences to which we have referred and which institution of the objective test standard was recommended by the Roosevelt-Kettering Commission would make it unnecessary to grapple with and define any of these factors to which the "substantial innovation" relates or to determine what is "substantial" in the term "substantial innovation."

This matter is more important than any diversity of decision of Courts upon the same patent. It is indeed the most important thing in the patent law and perhaps in the whole confines of industry and invention today. It is at

the very bottom of both industry and invention, as was found by the Roosevelt-Kettering Commission.⁷

One cannot find more widely diversified views and greater conflicts among different Courts of Appeals than exist upon this question. Its solution would save almost incalculable sums of money, time and efforts in litigation through the Courts in an effort to secure uniformity of decision through the Courts so that it could be determined in advance with some such certainty as formerly existed when a patent would be sustained and when it would not, since the question of invention and mechanical skill is involved in virtually every patent infringement suit. What we have said about litigation is equally true of negotiations regarding patent rights and the allowance of patents by the Patent Office.⁸

⁷ President Roosevelt's Patent Planning Commission, headed by Mr. Kettering, reported that "The American patent system" (as it was adjudicated) "stimulated American inventors to originate a major portion of the important industrial and basic inventions of the past 150 years; * * * stimulated creation and development of products and processes necessary to arm the nation and to wage successful war; * * * operated to protect the individual and small business concerns during the formative period of a new enterprise."

⁸ In the first decade after the introduction of this confusion, invention in the United States fell off over 50% per capita and the issue of patents fell off over 41% per capita (see Cleveland Engineering, September 5, 1946, page 7, and many other current and recent engineering and scientific journals). These doctrines prove what this Court said in *Patterson v. Kentucky*, 97 U. S. 501, 507, as follows:

"The ingenious man was, therefore, led either to abandon pursuits of this" (inventive) "nature, or to conceal his results from the world. The end of the" (patent) "statute was to encourage useful inventions, and to hold forth, as inducements to the inventor, the exclusive use of his invention."

In view of the specific confusion in the interpretation of the rule of the *Sinclair* decision between the First and Sixth Circuit Courts of Appeals, we will in this, our opening, brief limit our discussion of the confusions between these two Circuits.

Shepard's Digest shows about three and one-half columns of citations of the Cuno or so-called "flash of genius" decision since November, 1941 when it was handed down. We need not here point out the expense, trouble and confusion that has followed from all the litigation represented by these citations. This will give some idea of the expense and litigation which follows on a ruling in such serious dispute among the lower Courts and the Patent Bar; a similar line of litigation has already started, as we have shown, on the "substantial innovation" test theory, which could be ended now by making it clear, for example, that this decision affirms the "old or traditional test," as the First Circuit Court of Appeals holds.

Specific Confusion Between the First and Sixth Circuit Courts of Appeals on the Sinclair Decision, the First Circuit Holding That It Restores the "Traditional," "Old" or Objective Test and the Sixth Circuit Holding to the Contrary: This conflict is clear from the decisions in the First Circuit Court of Appeals in *Grant Paper Box Co. v. Russell Box Company*, *post*, and *Brown & Sharpe v. Kar Engineering*, *post*, and the decision of the Sixth Circuit Court of Appeals in the cause at bar and in other decisions which we are citing *post*, showing that at the present time in these two Circuits the First Circuit Court of Appeals is proceeding to hand down decisions on the theory that this Court's decision in the *Sinclair* case restored the traditional or old test and the Sixth Circuit Court of Appeals is consistently handing down decisions based upon the contrary conclusion, as we will point out.

First Circuit View of the Sinclair Decision: In *Brown & Sharpe v. Kar Engineering*, 154 Fed. (2) 48, handed down by the First Circuit Court of Appeals intermediate its two decisions in the *Grant Paper Box* case, *post*, that Court interpreted this Court's decision in the *Sinclair* case diametrically opposed to the decision of the Sixth Circuit Court of Appeals in the cause at bar.

In noting the presence of the objective tests (pp. 48-49) the First Circuit Court of Appeals pointed out through pages 50 and 51 the history⁸ and the confusion which now exists regarding the test of invention, pointing out that that Court had come to the conclusion that this

⁸ "The foregoing squarely presents us with the question whether the Supreme Court in the *Cuno* case intended to establish for the future a new and higher standard of invention than had prevailed in the past?

"This question has many times been given careful consideration by the circuit courts of appeals. Some seem to have regarded the *Cuno* case as the culmination of 'a pronounced new doctrinal trend' of the Supreme Court of 'a decade or more' standing which it was their 'duty, cautiously to be sure, to follow not to resist.' *Picard v. United Aircraft Corp.*, 2 Cir., 1942, 128 F. 2d 632, 636. Others have taken the view that in the *Cuno* case the Supreme Court did not intend to raise the 'standard of originality necessary for a patent' but only intended to restate the traditional test for invention. *In re Shortell*, 1944, 142 F. 2d 292, 295, 296, 31 C. C. P. A. Patents, 1062. For considered discussion of the question see *United States Gypsum Co. v. Consolidated, etc., Co.*, 6 Cir., 1942, 130 F. 2d 888, 892; *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.*, 7 Cir., 1943, 132 F. 2d 812, 817, 818; *Trabon Engineering Corp. v. Dirkes*, 6 Cir., 1943, 136 F. 2d 24, 27; *Cleveland Punch & Shear Works v. E. W. Bliss Co.*, 6 Cir., 1944, 145 F. 2d 991. In *Anderson Co. v. Lion Products Co.*, 1 Cir., 1942, 127 F. 2d 454, 457, and *Bellarance v. Frank Morrow Co.*, 1 Cir., 1944, 140 F. 2d 419, 423, although not necessary to our decisions, we indicated that we inclined to the view that the *Cuno* case set a higher standard for invention. Now, however, we think that view mistaken."

Court had changed the standard of invention, and then said (p. 51):

“Now, however, we think that view¹⁰ mistaken.”

The Court then interpreted this Court’s decision in the *Sinclair* case as a basis for the conclusion that its former view was mistaken and that the traditional test, i.e., the objective test, was still applicable. Thus the Court said (p. 52):

“and that a paragraph in *Sinclair & Carroll Co., Inc., v. Interchemical Corp.*, 325 U. S. 327, 330, 331, 65 S. Ct. 1143, decided after the judgment below was entered, definitely establishes that the traditional test is still applicable.”

Then the Court went on to apply the old test and find invention on the basis thereof (p. 52) as follows:

“Nevertheless, applying the old test in the present-day environment we think the tentative conclusion of patentable invention made below must stand.”

As we point out hereinafter, the Courts in the instant cause rejected the “tradition” or “old test” and proceeded on the former view adhered to by the Court of Appeals in the First Circuit and which that Court said it had concluded was a mistaken view.

In *Grant Paper Box Company v. Russell Box Company* the First Circuit Court of Appeals first held the patent invalid on authority of the *Sinclair* case and then, on Petition for Rehearing, held the patent valid on authority of the same case. The original decision is published at 151 Fed. (2) 886 and the Court said, after discussing the facts, at page 891:

“we see nothing for it in view of the *Sinclair & Carroll* case but to hold claim 3 of the patent in suit invalid for lack of patentable invention.”

¹⁰ This former and “mistaken view” is the view taken by the Sixth Circuit Courts in the cause at bar.

The patentee then filed a Petition for Rehearing which on consideration was granted and the Court reversed itself, holding the patent valid in view of the *Sinclair* case (see 154 Fed. (2) 729) where the Court, after discussing the facts again, said (p. 730) :

"therein lies the distinction between the case at bar and the *Sinclair* case."

Sixth Circuit View of the Sinclair Decision: In the cause at bar the Sixth Circuit Courts found the presence of the old or traditional test of invention to a remarkable degree, but took the view of the *Sinclair* decision which the Court of Appeals in the First Circuit repudiated on the rehearing in the *Grant Paper Box* case and which view is contrary to the current view of the First Circuit Court of Appeals in its later decision in the *Brown & Sharpe* case and on the rehearing in the *Grant* case as well.

The presence of the objective test in the cause at bar was stated by the District Court (II, pp. 784-785) and adopted by the Court of Appeals in its opinion (Vol. VI, p. 8), as follows:

"'Prior to 1932 there existed very serious clutch problems in the automotive industry. Such problems increased as the power and capacity of automobiles increased. The problem became quite acute about 1932 when the clutch linings then in use proved generally unsatisfactory for use in busses. The 'conventional liners' at that time consisted principally of asbestos fiber in woven or molded form combined with organic bonding materials. The friction to which these liners were subjected created such intense heat that it melted them. When their physical and operational properties were changed, their further use, if at all possible, became dangerous and unsatisfactory. * * *

"Many manufacturers were striving to devise a clutch lining that would slip smoothly when starting but would not slip when in driving engagement, that would not vary under varying conditions of pressure, temperature, and speed * * * and that would withstand

the centrifugal warping and twisting forces to which it was necessarily subjected.

"In 1932 the Twin Coach Company heard of plaintiff's 'friction article.' It obtained some of the friction material and with plaintiff's cooperation installed segments as liners in clutches of its busses. **These clutch liners gave amazing results.** They were subjected to severe acceleration tests and worked smoothly and proved to have remarkable durability. **The evidence leaves no doubt that there had been a very great problem, that repeated efforts had come short of solution, and that plaintiff's friction article supplied a long-felt need.** Metallic clutch liners in a comparatively short time supplanted the 'conventional liners' generally in the automotive industry.'"

The Court of Appeals then went on to say that these things were, however, not sufficient and cited this Court's decision in the *Sinclair* case, adding that there must be some substantial innovation in addition.

The District Court made the same observation based upon the *Cuno* and similar decisions and said, regarding the Court's inability, as the Court saw it, to hold invention in view of these decisions (II, p. 787):

"This the conscientious judge regrets. Instinctively he prefers the exercise of objective to subjective judgment. Naturally the court is prompted by a desire to see every man rewarded for whatever contribution he has made to art or industry."

Both Courts recognized that the inventor in the instant cause had made

"*a decided improvement over what had gone before.*" (Emphasis ours.) (CCA decision, Vol. VI, p. 14.)

It cannot be disputed that this view of the Sixth Circuit Court of Appeals and of the District Court in the instant cause that there must be something more to establish invention than the traditional or old test is directly contrary to the position taken by the First Circuit Court of Appeals. Also it cannot be disputed that both Courts in the Sixth

Circuit thought the invention was entitled to be rewarded but regretted that they felt that the reward due the inventor in the instant cause could not be awarded to him in view of the decisions of this Court which the First Circuit Court of Appeals has concluded do not defeat the sustaining of a patent which discloses such "a decided improvement over what has gone before."

In view of what has been found and held in the concurring decisions of the Courts in the cause at bar, it cannot be disputed that there is here present the following:

- (1) A substantial innovation in results or achievements (characterized as "amazing results" by the District Court).
- (2) A substantial contribution for which society is truly indebted to the efforts of the patentee.
- (3) A disclosure of advances in knowledge which are beneficial to society.
- (4) A substantial change in mode of operation in order to achieve the "amazing results" and these benefits.

Whether the change in structure in the structure claim is "a decided improvement over what has gone before," as the Court of Appeals suggested (Vol. VI p. 14) is immaterial in view of the repeated holdings by this Court—and all other patent Courts—that simplicity in structure is evidence of invention and not to be used to strike down an invention which achieved "amazing results" and accomplishes the other factors which we have mentioned (*Diamond v. Consolidated*, 220 U. S. 428, 434).

The Confusion Over the Sinclair Decision Continues and Will Continue Unless Now Resolved: Following this interpretation the Court of Appeals in the Sixth Circuit has cited the Sinclair decision in a number of decisions¹¹

¹¹ *O'Leary v. Liggett Drug*, 150 Fed. (2) 656, 661; *Rice v. Nash Kelvinator*, 150 Fed. (2) 457, 460.

since the Sinclair decision was handed down and held patents invalid following the interpretation given by that Court to the Sinclair decision which, as we have shown, is contrary to that of the First Circuit Court of Appeals. Thus, in the short time since the Sinclair decision was rendered (May 21, 1945) we are able to cite two decisions in the First Circuit and three decisions in the Sixth Circuit in which directly opposite views of the effect of the Sinclair decision are relied upon. These decisions all fall within the calendar year, and it is plain that unless this Court resolves this matter, year by year the two Courts will be rendering decisions on the different interpretations of the Sinclair decision—the First Circuit on the interpretation that the Sinclair decision restored the old or traditional test of invention and the Sixth Circuit on the interpretation that the Sinclair decision requires something more than the old or traditional test without anybody knowing just what that “something” more is.

So that in addition to the importance of providing the inventors and all those associated with him with a definition of invention as reliable as the old or traditional definition, there is the even more compelling reason of resolving the diversity of views between the First and the Sixth Circuits upon a principle which affects not one patent case, but all patent cases which are being considered and decided by these two Courts from year to year. Manifestly, the longer the question goes unresolved, the more confusion and waste will be caused by the conflict. Manifestly, there is no reason to wait until some particular patent is adjudicated in the First Circuit and the Sixth Circuit on the basis of the different interpretations of the Sinclair decision before taking up the question and resolving it.

It is well-recognized that this Court will grant certiorari where there is a conflict of interpretations of a particular patent between different Circuits on the question of invention, *Dow v. Halliburton*, 324 U. S. 321; and of an

apparent conflict with this Court and several Circuit Courts of Appeals, *U. S. Chemicals v. Carbide*, 315 U. S. 668; and where the question is of public importance, *Mercoid v. Mid-Continent*, 320 U. S. 661, 663. Manifestly it is all the more important that this Court should take up and resolve a conflict of views between two Circuit Courts of Appeals which are affecting most, if not all, of the decisions rendered by those two Courts of Appeals upon the question of invention day by day and year by year.

Nature of the "Decided Improvement Over What Had Gone Before" is the familiar and almost universal new combination of old elements recognized by this Court in many decisions to be patentable where such things as "amazing results" are achieved (*Expanded Metal v. Bradford*, 214 U. S. 366, 381; *Loom Company v. Higgins*, 105 U. S. 580, 591; *Goodyear vs. Ray-O-Vac*, 321 U. S. 253). Each of the Courts below found the ingredient of the filler in certain proportions in certain prior art patents and the network in some other prior art (see Findings 7, 8 and 9 of the District Court, II, pp. 789-790). The Court of Appeals followed these Findings, referring on page 9 to the filler and on page 12 to the network. The conclusion of the Court of Appeals is typical. It is to the effect that notwithstanding the "amazing results" and the presence of the old or traditional tests, and the fact that there is "decided improvement," there is "no invention over what had gone before." If we accept the conclusion that Fisher's inventions are improvement inventions, we must also accept the conclusion that they are decided improvements over what had gone before. Accomplishing the "amazing results," supplying the long-felt need, meeting with success and contributing so substantially to the public welfare and benefit, these improvements, therefore, come squarely within this Court's evaluation of improvement patents in the following language in *Eibel Company v. Paper Com-*

pany, 261 U. S. 45, 63, where Chief Justice Taft, speaking for this Court, said:

"Indeed, when one notes the crude working of machines of famous pioneer inventions and discoveries, and compares them with the modern machines and processes exemplifying the principle of the pioneer discovery, one hesitates in the division of credit between the original inventor and the improvers; and certainly finds no reason to withhold from the really meritorious improver, the application of the rule '*ut res magis valeat quam pereat*,' which has been sustained in so many cases in this Court. *Winans v. Denmead*, 15 How. 338, 341; *Corning v. Burden*, 15 How. 265, 269; *Turrill v. Railroad Co.*, 1 Wall. 491, 510; *Rubber Co. v. Goodyear*, 9 Wall. 788, 795; *McClain v. Ortmayer*, 141 U. S. 419, 425."

It is very plain from what both Courts said below that the decided improvements in the patents in suit are just such improvements as were discussed by Chief Justice Taft in the above statement. This has always been the rule in this Court and there is no reason that we can see for concluding that the Sinclair decision changed the rule. Certainly the First Circuit Court of Appeals does not think so.

The Old or Traditional Test is Sound and Reliable: In the instant cause the District Court found that the evidence leaves no doubt that there had been a great problem and a long-felt want, that repeated efforts of many manufacturers striving to solve the problem had failed, and that the patentee's invention gave amazing results and was adopted on its own merits over a wide range. (See quotations from opinions of District Court and Circuit Court of Appeals, *supra*.)

It seems incredible that it should be concluded that the solution of this problem was within the skill of a mechanic versed in the art for if it had been within such skill, the

problem would have been solved at once and would not have baffled the skilled mechanics, engineers and inventors of these many manufacturers for a long period of time, during which there was a constant need for the solution, as established not only by the Court's Findings, but by the widespread adoption of the invention when it was made.

This old or traditional defense based on the objective tests was essentially founded upon an advance which was beneficial to society without regard to the simplicity or complications of the advance. The presence of the objective test is merely evidence of this benefit to society. Evidence of need, struggle to supply the need accompanied by efforts and failures by those skilled in the art to solve the problem before the invention, and the adoption of the invention afterwards are all evidence of a benefit conferred upon society. Therefore, the resort to the objective tests was merely resort to and reliance upon the evidence which proved the requisite benefit to the public. That such was always accepted by this Court is not only established by the decisions which we have cited *supra*, but by the following statement made by Mr. Justice Roberts, speaking for this Court, in *U. S. v. Dubilier*, 289 U. S. 178, 188, as follows:

"the act of invention, which consists neither in finding out the laws of nature, nor in fruitful research as to the operation of natural laws, but in discovering how those laws may be utilized or applied *for some beneficial purpose*, by a process, a device or a machine. It is the result of an inventive act, the birth of an idea and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form. *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 489; *Symington Co. v. National Castings Co.*, 250 U. S. 383, 386; *Pyrene Mfg. Co. v. Boyce*, 292 Fed. 480, 481."

Moreover, this Court speaking through Mr. Justice Stone in *Paramount v. American Tri-Ergon*, 294 U. S. 464 stated the rule both ways as follows:

In defining invention by this old or traditional rule or objective test, the Court said (p. 474):

"Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want. See *Loom v. Higgins*, 105 U. S. 580, 591; *Krementz v. Cottle Co.*, 148 U. S. 556, 560; *Hobbs v. Beach*, 180 U. S. 383, 392; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 429, 430; *Expanded Metal Co. v. Bradford*, 214 U. S. 366, 381."

In defining non-invention the Court said (pp. 474-475):

"But the state of the motion picture art, as it is disclosed by the present record, indicates that there was no generally recognized demand for any type of film record, for the reproduction of sound to accompany motion pictures, until after the present patent was applied for. See *Hollister v. Benedict & Burnham Mfg. Co.*, 113 U. S. 59, 73. Compare *McClain v. Ortmayer*, 141 U. S. 419, 428; *Grant v. Walter*, 148 U. S. 547, 556."

Thus by this old or traditional rule the Courts were not only able to tell what was invention, but what was not, by this evidence.

In the instant cause invention must have been found by applying these rules to the facts found to be present by both Courts below. In fact, as we have pointed out, the District Court regretted that he could not find invention in the presence of these facts because of the—what we think is erroneous—interpretation of the Sixth Circuit Court of Appeals of this Court's alleged departure from the standards of invention pronounced in the above

quotations with which, as we have pointed out, the First Circuit Court of Appeals, and the other Courts of Appeals adhering thereto, have disagreed.

It follows, or so it seems to us, that this Court's pronouncement in the *Sinclair* case was merely a reaffirmance of what had always been practiced in this Court and the interpretation of the First Circuit Court of Appeals, the Court of Customs and Patent Appeals, the Seventh Circuit Court of Appeals and the other courts following this Court of Appeals is correct, and that of the Sixth Circuit Court of Appeals, the Second Circuit Court of Appeals, and other Courts adhering to the view of the Sixth and Second Circuit Courts of Appeals is erroneous.

It also follows that if this Court grants this Petition and reverses the Sixth Circuit Court of Appeals, all of the Courts below will be brought into line with the former decisions of this Court such as that in the case of *U. S. v. Dubilier*, *Paramount v. American*, *Expanded Metal v. Bradford*, *Temco v. Apco*, and others.

Judge Learned Hand on the Conflict and Confusion:

In a recent decision (July 25, 1946) in *Foxboro v. Taylor*, 157 Fed. (2) 226, Judge Learned Hand, speaking for the Second Circuit Court of Appeals reports both the conflict of decisions on the question of the standard of invention and the current confusion in the Courts because of their inability to ascertain what this Court considers to be the present standard of invention.

On the question of the conflict of interpretation among the Courts of Appeals of this Court's decisions relating to and present position on the question of the standard of invention, Judge Learned Hand, in stating the disagreement of the Second Circuit Court of Appeals with other Appellate Courts, says as follows (p. 234):

"Finally, when all else is said, we cannot ignore the change in recent years in the standard of invention

adopted by the Supreme Court. It is as idle to pretend that there has been no change (*In re Shortell*, 142 F. 2d 292, 31 C. C. P. A., Patents, 1062), as it would be to protest against it."

This is merely an expression of what we have already pointed out and, while Judge Hand mentions the conflict between the Court of Appeals in the Second Circuit and the Court of Customs and Patent Appeals only, we have pointed out that this conflict exists in the other Circuits.

On the question of the inability of the Courts to divine what is, in the view of this Court, the present standard of invention, Judge Hand says (p. 234) :

"We are to dispose of the question of invention, *so far as we can divine*, as we *think* the Supreme Court would dispose of it."

It is apparent from this statement, we believe, that even so learned a Judge as Judge Hand is relegated to an effort to "divine" what he "thinks" this Court regards as the standard of invention.

While Judge Hand points out emphatically the difference in view between the Second Circuit Court of Appeals and the Court of Customs and Patent Appeals, in the footnote to the decision he lines the Sixth Circuit up with the Second Circuit. It is manifest from what we have said above that the First Circuit is lined up with the Court of Customs and Patent Appeals and the Seventh Circuit stands between them.

This Court may think that it ought to resolve these two questions so that the lower Courts will not be forced to rely upon what a Court below thinks it can divine or cannot divine the standard of invention upon which this Court wishes the lower Courts to rely, especially when, as Judge Hand points out, there is confusion among the Courts in this thinking and this divining.

SUMMARY AND CONCLUSION.

The history of the confusion over this question succinctly is as follows:

(1) Prior to some time around the early 1930's the question of invention had been resolved largely and generally on the "objective test" referred to as the "traditional test" by the First Circuit Court of Appeals.

(2) The "shifting target test" was announced by the Third Circuit Court of Appeals in 1939 (*Armstrong v. United, supra*) predicated, as that Court declared, upon decisions of this Court beginning some time prior thereto. In changing from the "traditional test" to the "shifting target test" the Court of Appeals in the Third Circuit admitted its shifting nature and its departure from the traditional test" saying, by way of undertaking to console those whose rights, predicated upon the "traditional test," were destroyed by the change:

"We, therefore, express to them our regret for the sins¹² of the past."

thus admitting the change, the disastrous consequence upon the property based upon the previous administration of the law, and pronouncing the shifting nature of the target test because of the varying positions of the target. Need-

¹² What were these "sins" and their effect? The answer of the Roosevelt-Kettering Commission was:

"the patent system has been of inestimable benefit to the country in promoting industrial and scientific development, and may be regarded as one of the principal causes of American industrial supremacy,"

* * * * *

"(6) The fact that patents are keystones in many very important industries has been brought home to us with great emphasis. I doubt whether I had realized their significance as a primary force in the operations of the economic system."

less to say, this caused all kinds of confusion, dissatisfaction, waste and discouragement.

(3) The "flash of genius" test was then pronounced by this Court in 1941 in the Cuno decision (*Cuno v. Automatic*, 314 U. S. 84). This proved to be just as shifting and to cause just as much confusion and discouragement of invention as the shifting target test. As we have pointed out, the Courts below were unable to decide what was the meaning of the "flash" and what was the meaning of the "genius" involved. The confusion and disaster continued.

(4) In these premises President Roosevelt appointed the Kettering Patent Planning Commission to try to still these confusions, etc. This Commission made its report recommending, as we have said, the "objective test" which is the "traditional test." This was in 1943. However, this recommendation was not adopted by the Courts, so the confusion continued.

(5) Then, in 1945, this Court handed down its opinion in the *Sinclair* case pronouncing the "substantial innovation" test. Whether this Court thereby intended to restore the "traditional test," recommended by the Roosevelt-Kettering Commission as the First Circuit Court of Appeals interpreted it, or to set up a new test, as the Sixth Circuit Court of Appeals has interpreted it, is now unsettled and the cause of continued confusion. If the Sixth Circuit Court of Appeals is correct, then it is manifest that all the institutions relating to patents are in the same confusion as has existed ever since the "shifting target test" was instituted. If the First Circuit Court of Appeals is correct, then all of these institutions are restored to the stable condition existing before the institution of the shifting target test.

There is nothing so important in the patent law as a declaration by this Court of its interpretation of the "substantial innovation" test of the *Sinclair* decision and a re-

solving of the difference of views of the First and Sixth Circuit Court of Appeals which will, unless now resolved, continue and spread to the other Circuits until this Court must, we think, ultimately find it necessary to settle the disputes.

There are then two important reasons for granting certiorari in the instant cause, as follows:

First, to resolve the conflict between the First and the Sixth Circuits on the question of whether or not this Court in the Sinclair decision restored the "old" or "traditional test" of invention, or whether it did not, as a result of which the Courts are deciding the question of invention on different bases, and

Second, if the Court of Appeals in the Sixth Circuit is correct, then certiorari should, we think, be granted to state in which of the features relating to patentable invention the "substantial innovation" must be made and what degree of "substantial innovation" in such phrase determines invention as against mechanical skill so that Judges like Judge Learned Hand will not resort to efforts to "divine" how they think this Supreme Court would dispose of it with the result that some arrive at one result and others at different results.

Respectfully submitted,

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JAN 16 1947

CHARLES ELMORE GROPEL
CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 792.

THE GENERAL METALS POWDER COMPANY,

Petitioner,

vs.

THE S. K. WELLMAN COMPANY and S. K. WELLMAN,

Respondents.

**PETITIONER'S REPLY BRIEF ON ITS
PETITION FOR CERTIORARI.**

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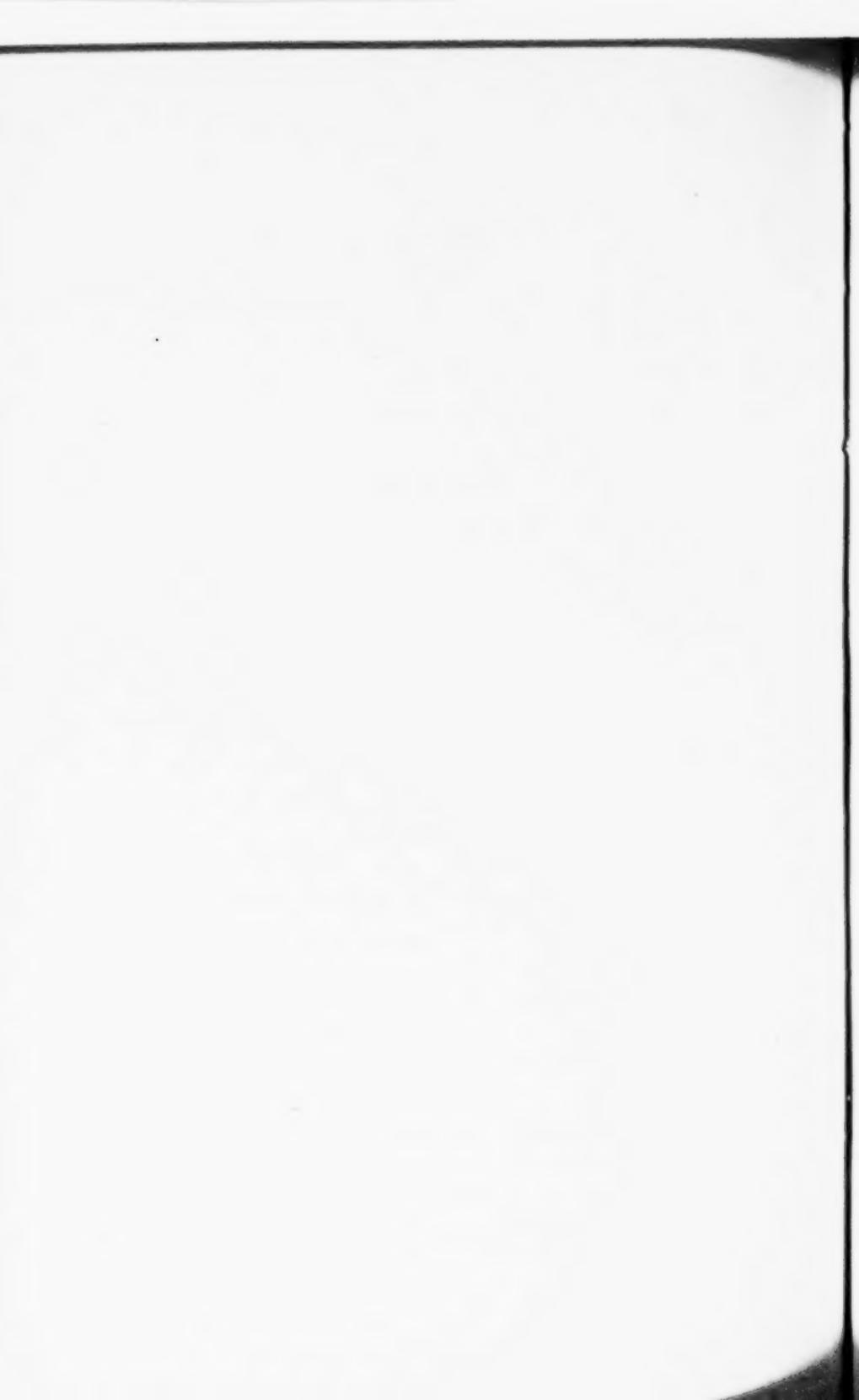


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Now comes Petitioner and prays leave to file the following brief as a reply to the Respondents' Brief:

I.

The claims were held invalid on the sole reason of "lack of invention." The new combination recited in the claims includes two sub-combinations called the (1) "metal network" or "metallic network" and the (2) "composition."

The Courts found that each of these sub-combinations was old in the prior art, but did not find that both had ever been included in the same method or same structure. The finding of lack of novelty was, therefore, based upon, and could only mean that these separate sub-combinations were found to be old in different constructions or methods.

Thus Finding of Fact 6 (II, p. 789) relates only to the "metal network." It was not, therefore, the entire combination which the District Court found that the plaintiff had been in error in its representations to the Patent Office, but only this "metal network" or one feature of the combination claims.

In Finding of Fact 7 the Court found that the "metal network" was present in certain prior art patents, but did not find that the entire combination, including the "composition," was present in any of these prior art patents.

In Finding of Fact 8 the same finding was made. That finding is also limited to the "network," as was the comment regarding the demonstrations of the experts in *inter partes* tests. The Court did not find that the entire combination of any of the claims was either in any one of these prior art devices or was demonstrated by the testimony of these experts.

In Finding of Fact 9 the Court found that the other sub-combination, i.e., the "composition" was old in certain prior art, but did not anywhere find that the entire combination was old.

These findings of the presence of certain elements of the combinations in some prior art devices and the presence of some other elements of the combinations in some other prior art devices are made throughout and supported by the proof. There is no finding that the entire combination of any of the claims is found in any prior art device or method and no proof to support any such conclusion. This, of course, explains the finding of "novelty." If the Court had found any of the entire combinations present in the prior art, the finding would have been one of "anticipation." The finding of lack of novelty is, therefore, nothing but the finding of non-invention where different features found in the combination claims are taken from different prior art disclosures and combined by means of hindsight to form a new combination of elements or steps which perform the "amazing results" which the defendant attempts to dissipate by characterizing them as a "gratuitous observation in the opinion." These are very positive statements in the opinion, which are supported by the undisputed testimony in the record. It is also supported by the defendant's own pronouncements.

Specimens of these proclamations are:

(R. Vol. III, 363) :

"It can't be burned out. You can ride it all day and you won't hurt it. It wears like a pig's nose.

* * * * *

"Think of the market for it among the fleets and trucks where they overload the jobs and then wonder why ordinary facings give out.

* * * * *

"It is non-competitive, there isn't another one on the market."

(R. Vol. III, 364) :

"the molded lining that has never yet been known to score a brake drum. The lining which cures noisy brakes and brings you satisfied repeat business.

* * * * *

"the lining which wears and wears and wears."

(R. Vol. III, 365) :

"You CAN'T BURN THEM OUT. They wear like a pig's nose. For those jobs where the Driver 'Rides the Clutch' or holds the car on grades without a brake, These Facings are the Answer.

"Trucks * * * Where they Overload 'em; Passenger Cars * * * Where they Ride 'em; Automatic Clutches * * * Where they Slip 'em; They're all alike to VELVETOUGH METALLIC FACINGS. You want to know about them, The More Than Modern Facings.

"Every Maintenance Man and Fleet Operator that's seen Them Wants Them * * * They're That Kind of Item."

See also R. Vol. III, 369.

These pronouncements made to the world by defendant relate to the defendant's doings found to infringe by the Court below. They support the pronouncements of the District Judge in his opinion to which we have referred. These

statements in the opinion of the District Judge supported by this evidence pronounced by the defendant would be more reliable than any Findings of Fact to the contrary, if there were any such Findings of Fact to the contrary since, as is well known, the prevailing counsel participates in the preparation of the Findings of Fact, if he does not, in fact, write them. But supported by defendant's pronouncements and uncontradicted by a finding the opinion must prevail.

II.

Definition of Invention. Counsel suggest that we have not suggested a definition for invention. This also is incorrect. We have suggested that there be adopted the definition suggested by President Roosevelt's Patent Planning Commission headed by Mr. Kettering (see p. 8 of our Petition and Brief) and which, as is well recognized, was the definition followed for something like one hundred years in the administration of the patent law and is the one referred to by the First Circuit Court of Appeals as the old, or traditional, test (see p. 16 of our Petition and Brief). We need no legislation and need have no misgivings about returning to this test. It was followed for something like one hundred years by the patent Courts in this country under the present patent statutes and has, as those Courts said, proved to be eminently satisfactory as shown by the tremendous progress made in science, invention, mechanics, etc., to the benefit of all during the years when that test was employed and that definition adhered to.

The instant cause presents a perfect case for its application. Here we have new combinations of old elements or steps which achieve "amazing results," which greatly benefited the public and which were widely adopted because of their merits and because they supplied a long standing want and need. They also solved problems which baffled the industry and those skilled in the industry over a long

period of time. (All of these things were found by the District Court and recited in the Court's opinion, see page 18 of our Brief on our Petition.) Where these facts existed the Courts applying the objective test found the presence of new combinations of old elements or steps sufficient even though the change was slight. Under this test the Courts were persuaded by the achievement and the benefit conferred upon the public and gave little weight to the character of the change. Indeed, modest changes in structure or method were held to support the presence of invention and not defeat it.

III.

Conflict and Confusion Below. That there does exist confusion in the Courts of Appeals regarding the Sinclair decision is clear from not only the conflict which we pointed out in our brief, but from the fact that the First Circuit Court of Appeals gave different interpretations to the Sinclair decision on the main hearing and on the rehearing in the *Grant Paper* case, and, further, by Judge Hand's comments made in the *Foxboro* case since the Sinclair decision was handed down (see pp. 25 and 26 of our Petition and Brief.)

That each of these cases was not, and cannot be, treated upon its own particular facts is manifest from the fact that the First Circuit Court of Appeals came to such different interpretations of the Sinclair decision that upon the same set of facts it first found the patent invalid and then found it valid. The confusion to which Judge Hand refers and under which he is left to divine what he thinks this Court would do is also predicated upon a definite set of facts. Where the old, or traditional, or objective test was applied, the Courts were able, and did within reasonable limits, apply the rule to any and every set of facts. There were many sets of facts, such as were stated by the District Court to appear in this cause, and which do appear in this

cause, under which the finding of invention under this old test was clear. There were again other sets of facts under which non-invention was to be found under the objective test rule formerly applied. That there may have been some twilight zone sets of facts where the question was in dispute is immaterial. The most that could be said was that sometimes the application of the rule was in doubt. However, the twilight zone cases were few, whereas, as we have pointed out, under existing conditions there is confusion with respect to almost every case, as appears from the decisions which we have cited and discussed in our Petition and Brief.

Thus, not only is a definition of invention possible, but an eminently satisfactory definition of invention was adopted and followed for something like one hundred years and its reinstitution was recommended by the Kettering Patent Commission. All we are asking this Court to do is to adopt that recommendation, reinstate the definition which was so satisfactory and under which so much progress was made, and direct its application to the instant cause where the District Judge said that as a conscientious Judge he "regretted" that he could not apply it because of present conditions as he understood them, and was unable to do so without a change in the basic law (II, p. 787) whereas there would need to be no change in the basic law because under the currently existing law this definition was adopted and followed for something like one hundred years by this and other Courts.

Respectfully submitted,

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THE GENERAL METALS POWDER COMPANY,
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S. K. WELLMAN,

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—
**BRIEF OF RESPONDENTS IN OPPOSITION TO
PETITION FOR THE WRIT OF CERTIORARI.**

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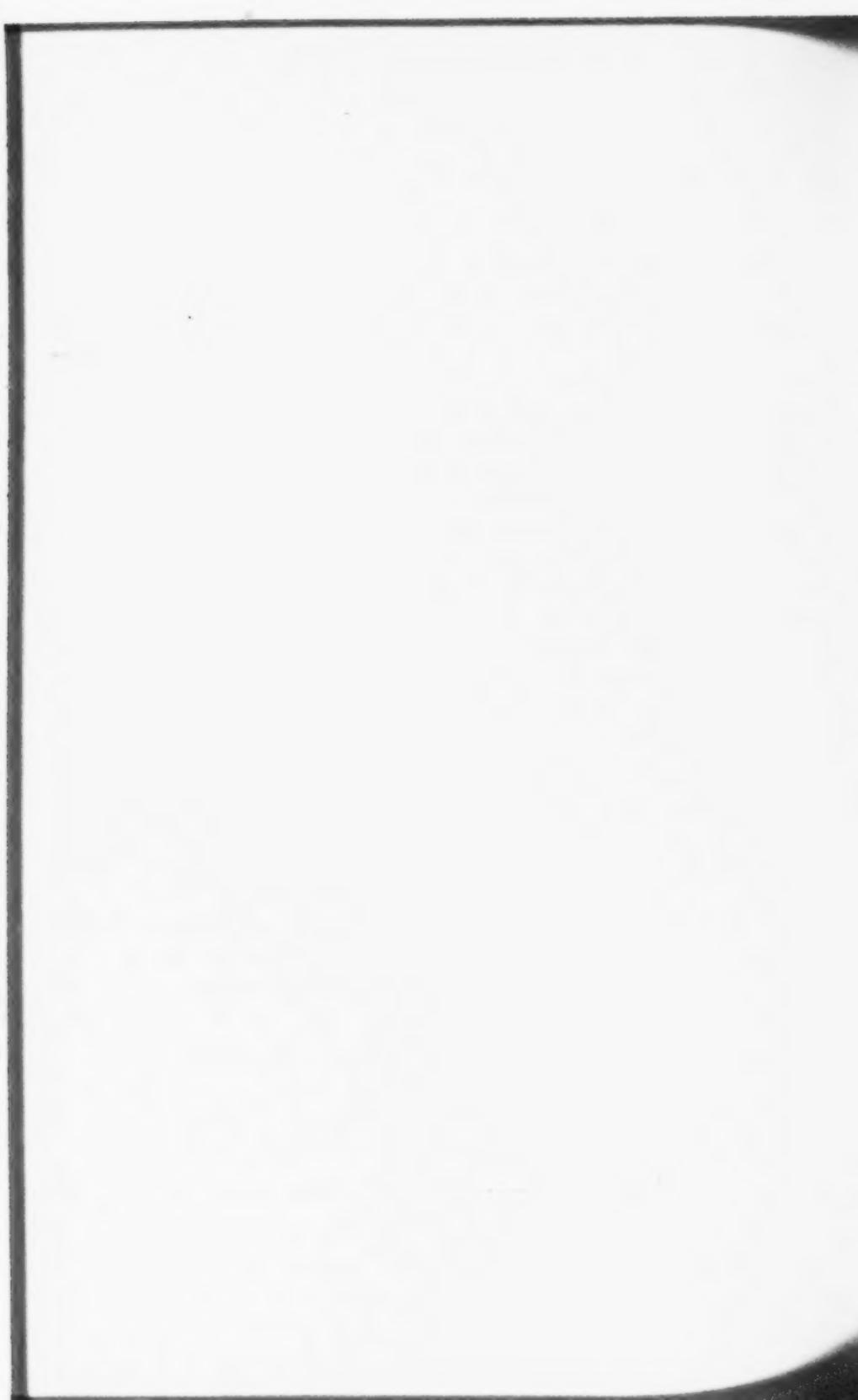


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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1946

NO. 792

THE GENERAL METALS POWDER COMPANY,
Petitioner,
vs.

THE S. K. WELLMAN COMPANY and
S. K. WELLMAN,
Respondents.

**BRIEF OF RESPONDENTS IN OPPOSITION TO
PETITION FOR THE WRIT OF CERTIORARI.**

STATEMENT OF THE CASE.

No showing is made of any special or important reason why this Court should grant the petition for the writ of certiorari. There is no conflict of decisions. On the contrary the concurring opinions of the District Court (R. Vol. II, pp. 783-788) and of the Circuit Court of Appeals affirming the District Court (R. VI, pp. 2-17; also 157 F. (2nd) 505) followed well recognized rules of law applicable to the particular facts of this cause.

This is a usual patent case grounded on two patents, to-wit: Fisher Patent No. 2,072,070, issued February 23, 1927, (R. III, p. 1) Claims 2, 3, 5, 12, 13, 14, 18 and 19 being relied upon; and Fisher Patent No. 2,191,460, issued February 27, 1940, (R. III, p. 17), Claims 1, 3, 5, and 6 being relied upon.

These two patents relate to a very old art,—that of powder metallurgy. The record discloses that the articles and the processes involved had long been known. Broadly, the articles long had been made by mixing desired metal powders and other materials and pressing them in a mold and sintering (heating) them (Findings 5 and 15, R. II, pp. 789-790).

The Fisher '070 patent relates to ". . . friction articles . . . adapted to withstand service conditions encountered in relatively moving bodies in contact with each other, such as in brakes, clutches and similar devices" (R. III, p. 7).

The patent states that "the term 'friction article' as used herein, means and includes, and is intended to mean and include, metallic bodies which cooperate with other parts of clutches and brakes to create the friction necessary for driving or braking purposes" (R. III, p. 13).

The Fisher '460 patent (R. III, p. 17) is concerned with the welding of a powdered metal body to a steel or other suitable backing member.

The "reasons relied upon" for allowance of the writ (Petition, pp. 2-4), "the issues" set forth in Petitioner's brief (pp. 5, 6) and the brief throughout, are directed to the question of the meaning of the term "invention". It is asserted that a diversity of opinion exists in our courts as to this. This Court is asked by petitioner to "furnish industry, the inventing profession, the patent law profession, the Patent Office, and the patent law courts with a definition of invention" . . . which definition it is asserted will accomplish certain allegedly desirable results (Petitioner's Br. p. 6).

While the District Court found that the claims in suit of the two Fisher patents would have been held infringed could they be held valid (R. II, p. 791), the petition is erroneous in stating that "the judgment of the District

Court dismissed the complaint *on the ground that, as to the claims in suit, the patents were invalid for lack of invention*"* (Petition, p. 2).

It is true that the District Court held both patents in suit invalid for lack of invention (Findings 10, 11 and 16, R. II, pp. 790-791), which holding was affirmed by the Court of Appeals, but the District Court also held the claims involved of the two patents in suit invalid on other grounds as well.

The "Judgment" of the District Court was a dismissal of plaintiff's action (R. II, p. 822).

The alleged novelty of the Fisher patent No. 2,072,070 over the prior art was the residence in the "friction article", to which it related, of a "metallic network".

The District Court findings of fact in respect to this patent were: that the Patent Office was induced to grant it by erroneous assertions made by the applicant (Finding 6, R. II, p. 789); that its metal network structure was revealed in Defendant's Exhibit 48 made as early as 1922 (Finding 7, R. II, p. 789); that it was lacking in novelty over the Williams Patent of 1925, and over the Claus patent of 1927; and that the lack of novelty of the claims in suit was demonstrated by the testimony of the experts and inter-partes tests (Finding 8, R. II, p. 789). Also, that the structure embodied in the claims in suit of the said Fisher patent were, prior to Fisher, made by one Koehler; and that there was a prior sale of the friction article of the said Fisher patent and a use of it by one company in 1928, and another prior use as early as 1920 (Finding 9, R. II, pp. 789-790).

This makes it clear that the Findings of the District Court were not only Findings Numbers 10 and 11 relating to lack of invention, but also that the Court found that the

*Italics supplied throughout unless otherwise noted.

said Fisher patent was invalid because of erroneous representations made to the Patent Office in securing it, because of lack of novelty, and because of prior sale and use.

The District Court's Conclusion of Law Number 2 (R. II, p. 791) was that the claims in suit of the said Fisher Patent No. 2,072,070 "are invalid for lack of novelty over the prior art". "Lack of invention" is covered by Conclusion of Law Number 3 (R. II, p. 791).

The petition is likewise in error in setting forth that "lack of invention was the ground of dismissal" in respect to the other Fisher patent in suit,—No. 2,191,460 (Petition p. 2). There were additional grounds.

The District Court's Finding Number 14 is that the claims in suit of the Fisher patent '460 "are invalid for lack of novelty. They are anticipated by the Patent to Short No. 1,819,272 which was issued on August 18, 1931, on application filed September 22, 1927" (R. II, p. 790).

As to the method of welding, Finding Number 15 is that this was well known prior to Fisher's alleged invention *and that it had been used by the defendant itself*, prior to Fisher's alleged invention (R. II, p. 790).

Finding 16 is that the Fisher '460 patent is invalid *for lack of novelty* and lack of invention over the prior art (R. II, p. 791).

Conclusion of Law Number 4 is that the claims in suit of this Fisher patent are invalid for lack of novelty over the prior art (R. II, p. 791).

Conclusion of Law Number 5 is that they are also invalid for lack of invention over the prior art (R. II, p. 791).

The affirmance by the Circuit Court of Appeals was complete (R. VI, pp. 2-15, 17), (157 Fed. (2nd) 505). The Court's opinion discloses that a careful review was made.

In respect to the claims in suit of the Fisher patent 2,191,460, the Court of Appeals observes that in referring to the District Court's action "the Court held that this patent was invalid for lack of novelty and invention and that it was anticipated by Short No. 1,819,272, August 18, 1931. We think this conclusion is sustained" (R. VI, p. 16).

Thus this Fisher patent as to the claims sued upon has been held invalid for lack of novelty as well as for lack of invention by the District Court and also by the Circuit Court of Appeals.

As to the phrase "amazing results" found in the District Court's opinion, that Court's findings make it clear that whatever considerate meaning was intended, by this gratuitous observation in the opinion, the means by which the results were obtained, to-wit: the "friction article" of the first Fisher patent, was distinctly found by the Court in several items of prior art, prior patents, prior publications, prior sales and prior uses. It is in the findings, in the conclusions, and the judgment of the District Court that these authoritative pronouncements appear.

That the two agreeing courts were fully justified in holding the claims of the Fisher patents in suit invalid, we shall endeavor to briefly point out in the argument following.

ARGUMENT.

That the two concurring courts were fully warranted in holding the Fisher patent 2,072,070 invalid for lack of novelty is shown by the Williams Patent No. 1,556,658 (R. IV, p. 515). Its composition is the same as Fisher's. The process is the same old process as the District Court found. "The structural condition called a network in the Fisher patent" was old in Williams (R. II, p. 789). It should be obvious that the same material subjected to the same process

should give the same results. This was demonstrated by Dr. Wulff in inter-partes tests described by Dr. Wulff (R. I, pp. 427-437, R. IV, pp. 661-803, summarized R. I, pp. 436-437; See also Deft.'s Ex. 10, R. IV, pp. 800-803).

The lack of novelty in the '070 Fisher patent was also shown by Gilson Patent No. 1,177,407 (R. IV, p. 485). Also it is disclosed by the Claus Patent No. 1,648,772 (R. IV, p. 527).

Two chart pages from Deft.'s Physical Exhibit 44 identified by Dr. Wulff (R. II, p. 456) are inserted in this brief as Exhibit A which give a quick review of the prior art which invalidates the 2,072,070 Fisher patent.

That the said Fisher patent is invalid for lack of invention as well, is shown by the anticipating prior art such as the Williams Patent No. 1,556,658 (R. IV, p. 515); the Gilson Patent No. 1,177,407 (R. IV, p. 484); the Claus Patent No. 1,648,772 (R. IV, p. 527); the Hudson prior use (R. II, pp. 500-524, R. IV, pp. 837-952); the Guay Patent No. 1,700,493 (R. III, p. 154); the Gilson Block, Pltf.'s Ex. 48 (R. II, p. 507); the prior knowledge and use of Koehler (R. I, pp. 358 to 365); and the prior use of Cleveland Crane & Engineering Company (R.I, pp. 319-355, R. IV, p. 442). It is also shown by the Koehler Patent No. 1,479,859 (R. IV, p. 491); Williams Patent No. 1,766,865 (R. III, p. 253); Sherwood Patent No. 1,873,223 (R. IV, p. 573); Gilson Patent No. 1,093,614 (R. IV, p. 481).

As to the Fisher patent No. 2,191,460, the Short patent No. 1,819,272, which was issued August 18, 1931 on application filed September 22, 1927 (R. IV, p. 569) is an anticipation as found by the District Court and affirmed by the Circuit Court of Appeals. This patent discloses a porous metallic facing welded to a denser metallic backing. That it anticipates is clear from a mere comparison of the Short

patent's disclosure with that of the 2,191,460 Fisher patent in suit. That the said Fisher patent is also void for lack of invention is shown by abundant evidence on the record which wholly supports the finding of the District Court on the "invention" issue.

Fisher contributed nothing to the art. The "friction article" of his first patent 2,072,070 was old. The welding of this to a backing plate to which the Fisher patent 2,191,460 relates was old,—and old with the defendant before Fisher made his alleged invention as the District Court found (Finding 15, R. II, p. 790).

We shall not attempt to analyze or reply to the many decided cases cited and quoted in petitioner's brief. Petitioner's discussion of theories and of tests respecting "invention" overlooks a few tests of patentability. Novelty is one; prior use, prior sale, prior knowledge and prior publication are the others. These are set forth in the Patent Act (R. S. Sec. 4886; U. S. Code, Title 35, Sec. 31).

On the record in the instant cause the petitioner's philosophizing on the subject of "invention" seems academic. However, it may be observed that petitioner hopes for too much in asking this Court to define "invention". It is thought that it would be as difficult to give this legal term a definition of specificity as it would be to define "reasonable conduct", "mechanical skill", "reasonable time", "necessity" or other equally naked words or phrases. All of these, like the word "invention", must be fully dressed with facts in a particular case before there is any stuff out of which definition can be fashioned. Also, it may be observed that the urgent "prayer" found on page 6 of the petition for a "definition of invention" is not accompanied by any specific suggestion as to how anyone can evolve the definition requested.

In respect to illustrative decided cases, the Circuit Court of Appeals mentioned some in its opinion, and related them to the facts at bar. For instance, the opinion states:

“There must be ‘some substantial innovation . . . , an innovation for which society *is truly indebted* to the efforts of the patentee.’ (Italics ours.) *Sinclair & Carroll Co., Inc. v. Inter-Chemical Corp.*, 325 U. S. 327, 330. It is elementary that invention must involve something more than the work of a skilled mechanic charged with the state of the prior art.”

We do not understand from petitioner's brief that such principles as these are attacked. They have been followed for long years.

It would be difficult to choose language more aptly applicable to the lack of novelty found as a fact by both the trial and reviewing courts, than that quoted from the opinion of the Circuit Court of Appeals.

The petitioner's argument (page 14 of Brief) that this Court's *Sinclair* decision has brought confusion into the law respecting “invention” is unwarranted. Each of the cases to which Petitioner refers of necessity was treated upon its own particular facts. The question of invention must always be resolved by the exercise of judgment upon facts adduced. Facts differ, and courts sometimes differ in their views respecting them. It follows that every court opinion must be read with the admonition of Chief Justice Marshall in mind:

“It is a maxim not to be disregarded, that general expressions, in every opinion, are to be taken in connection with the case in which those expressions are used. If they go beyond the case, they may be respected, but ought not to control the judgment in a subsequent suit when the very point is presented for decision. The reason of this maxim is obvious. The question actually before the court is investigated with

care, and considered in its full extent. Other principles which may serve to illustrate it, are considered in their relation to the case decided, but their possible bearing on all other cases is seldom completely investigated." *Cohens v. Virginia*, 6 Wheaton 264, at 399; 19 L. Ed. 262, at 398.

Since the District Court with complete justification found the first Fisher patent in suit invalid for lack of novelty, because of prior use, prior sale, prior knowledge, prior publication, and lack of invention, and upon equally good warrant, found the second Fisher patent invalid for lack of novelty and lack of invention, and since each of these determinations was affirmed by the Circuit Court of Appeals, the petition for the writ of certiorari should be denied.

Respectfully submitted,

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CHARLES EDMUND MURRAY
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In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 792.

THE GENERAL METALS POWDER COMPANY,
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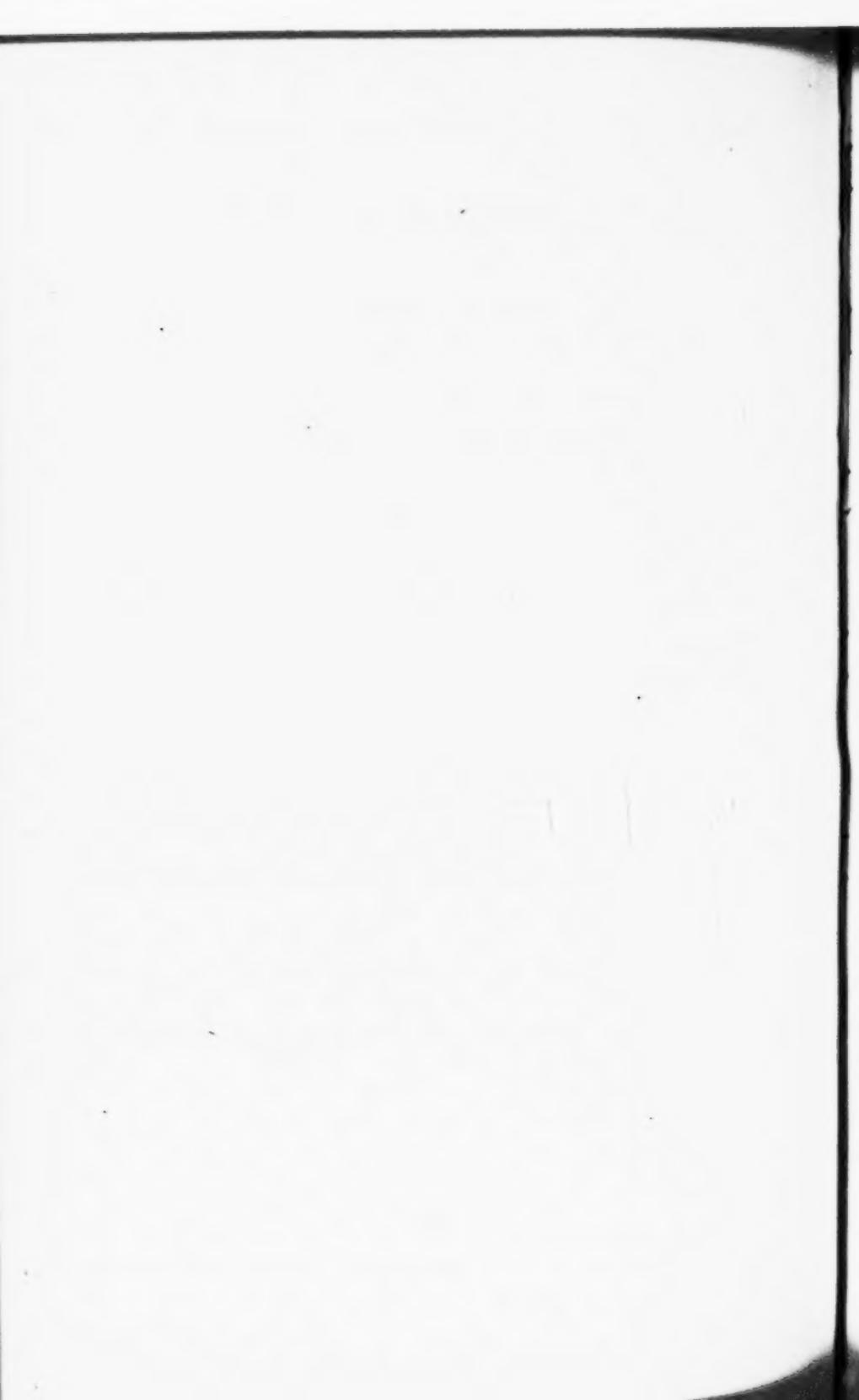
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Respondents.

PETITION FOR REHEARING ON THE PETITION FOR CERTIORARI.

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PETITION FOR REHEARING ON THE PETITION FOR CERTIORARI.

*To the Honorable the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Since our Petition was filed other Court decisions have come to our attention which were rendered since the collection of decisions we cited showing the present confusion on the question of the standard or test of invention. Among these is the decision of the Eighth Circuit Court of Appeals in *Koochook v. Barrett*, 72 U. S. P. Q. 27. The Court of Appeals, in reversing the lower Court, found non-invention based upon the standard set, or held by many courts to have been set, by this Court in what is known as the "flash of genius" decision (*Cuno v. Automatic*, 314 U. S. 84).

As we pointed out in our Petition, some of the Courts had held that the standard of invention was raised by this Court in *Cuno v. Automatic* and others that it was not, and still more confusing the First Circuit Court of Appeals held that the standard of invention set in the *Cuno v. Automatic* decision had been abandoned by this Court in its decision in *Sinclair v. Carroll* and the old, or traditional, test which existed prior to *Cuno v. Automatic* had been restored.

It is apparent from reading the decision of the Eighth Circuit Court of Appeals in *Koochook v. Barrett* that the Court below had relied upon this old, or traditional, test, but that the Court of Appeals had relied upon the test of *Cuno v. Automatic* as the opinion shows (72 U. S. P. Q. 305, 31). The Court below not only cited the *Cuno* decision but quoted extensively from it on the subject. Thus we have the record of no end to this confusion among the Courts in the different circuits below on this question, and no end to the litigation and expense that is going on because of this confusion and uncertainty. We are, therefore, renewing our prayer that this Court take up the instant cause and settle this question to stay this confusion and this waste.

Specifically the question is :

Is the question of invention in patent suits to be determined on the old, or traditional, test, or to be determined on some higher standard of test and, if so, on what standard? No one, of course, has the authority or the power to stay this confusion and expense except this Court and, as we pointed out in our Petition, it is squarely presented in the instant cause where the District Judge said that he would prefer to resort to the old, or traditional, test, but did not think he had the authority to do so, which is in direct conflict with the decisions in the First Circuit where it is being applied and resorted to.

The confusion to which we refer, and the apprehension regarding it, is not limited to the Patent Bar, but extends to Research Engineers, Inventors and Judges in the lower Courts. All of this is characterized by the following quotations from an address by Judge Moskowitz of the Eastern District of New York, appearing at 5 F. R. D. 361, 375 and 376:

"My associate, Judge Clarence G. Galston, in a well-considered address entitled 'The Imperiled Position of Our Patent System,' focused attention upon a development in Federal law, the significance of which extends far beyond the particular litigation in which it has be-

come noticeable. I refer to the trend toward invalidating patents. Our industrialization has progressed rapidly under a system which encourages competitive research and invention by affording relative assurance of compensation for successful creative effort. Those who argue that invention would continue although the reward be removed are overlooking human experience; the greater the protection afforded an inventor, the greater will be his endeavors.

* * * * *

"But many patent lawyers and research engineers have become apprehensive that the Supreme Court has pronounced an entirely new concept of invention, whereby a new device 'however useful it may be, must reveal the flash of creative genius'."

The confusion to which Judge Moscowitz refers, and to which we have referred, is illustrated by the local situation here in Cleveland, Ohio. In the Federal Court House there are two Court Rooms—one presided over by His Honor Judge Jones, and the other presided over by His Honor Judge Wilkin, who tried the cause at bar. When counsel go to the Court House to try a case there is no way of knowing whether the case will be tried by Judge Jones or Judge Wilkin.

Judge Jones follows the old, or traditional, test of invention, as indicated by the following statements by him in his opinion in the case of *Merco Nordstrom v. Acker* (Judge Jones' opinion is unpublished, but the opinion of the Court of Appeals appears at 131 Fed. (2) 277). In applying this old, or traditional, test Judge Jones said:

"In this case there has been quite a lot of time devoted to the earlier art. It is quite clear that people for countless years have been endeavoring to find means or construction for preventing leakage in flow lines and also for preventing sticking of valves, and particularly when an emergency is presented, as was described in the case out west where an earthquake occurred."

and found invention present.

In the other Court Room, presided over by Judge Wilkin, the old, or traditional, test is not followed, as we have shown at pages 17 and 18 of the Brief on our Petition for Certiorari where, though Judge Wilkin found all of these tests present, he said he regretted he could not apply them although, as we have shown, right across the Court House corridor Judge Jones is applying them.

In our Petition for Writ of Certiorari we contended, correctly, we think, that the courts are in a state of confusion in the tests of invention. Meanwhile, we honor the hundredth birthday of Thomas A. Edison and acknowledge that his discoveries and inventions have created many new industries and new jobs, and that they have solved many problems of long standing. These are important objective tests, and, are the true "surveyor's stakes" by which invention can be measured. The present confusion can result only in loss to the nation as a whole.

It is deemed unnecessary to repeat here, except to pray the Court to re-examine the points brought out by the Petition and to grant the writ.

Wherefore, it is prayed that the Petition for Writ of Certiorari in the above entitled cause be re-examined and re-considered and that the writ be granted.

Respectfully submitted,

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B. D. WATTS,

Counsel for Petitioner.

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1150 Union Commerce Bldg.,

Cleveland 14, Ohio,

Of Counsel.

Feb. 24, 1947.

I hereby certify that the foregoing Petition for Re-hearing is filed in good faith and not for the purpose of delay.

B. D. WATTS.